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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,948	03/12/2001	Marco Nahmias Nanni	7040.0008.02	7866

22852 7590 09/25/2002

FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20006

EXAMINER

MAKI, STEVEN D

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 09/25/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-7

Office Action Summary	Application No. 09/802,948	Applicant(s) NANNI ET AL.	
	Examiner Steven D. Maki	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 22-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 22-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/041,951.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

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1) The disclosure is objected to because of the following informalities: the continuity data needs to be corrected so as to describe this application as being a continuation-in-part of 09/472019. The original figures of this application but not 09/472019 include a color figure.

Appropriate correction is required.

2) The drawings are considered to be informal because they fail to comply with 37 CFR 1.84(a)(1) which requires black and white drawings using India ink or its equivalent.

Photographs and color drawings are acceptable only for examination purposes unless a petition filed under 37 CFR 1.84(a)(2) or (b)(1) is granted permitting their use as formal drawings. In the event applicant wishes to use the drawings currently on file as formal drawings, a petition must be filed for acceptance of the photographs or color drawings as formal drawings. Any such petition must be accompanied by the appropriate fee as set forth in 37 CFR 1.17(i), three sets of drawings or photographs, as appropriate, and, if filed under the provisions of 37 CFR 1.84(a)(2), an amendment to the first paragraph of the brief description of the drawings section of the specification which states:

The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings have been satisfied.

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No petition has been received in this application. This application fails to contain three sets of color figure 6. This application fails to contain an amendment to the first paragraph of the brief description of the drawings as set forth above.

3) The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.

With respect to "reviewed and understand the contents", the declaration describes "the specification of which was filed as United States Application Serial No. _____ on March 13, 1998" (a 27 page specification with a black and white figure 6) which is not the same as the specification filed in this application (a 25 page specification with a color figure 6).

4) The original claims 26-46 have been renumbered as claims 1-21.

In view of (a) the above noted renumbering and (b) the instruction to cancel claims 27-46 and to add new claims 22-37, claims 2-21 have been canceled and added claims 47-62 have been renumbered as claims 22-37.

The following claims remain pending: Claims 1 and 22-37.

5) The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6) Claims 24-26 and 29-37 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claim 30, the subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention (the new matter) is: the description of "the first reinforcing filler includes an amount of white filler effective to achieve a tyre operating temperature lower than a reference temperature. The original disclosure describes reducing an operating temperature by using a **difference** in amount of white filler instead of an effective amount of white filler in the first composition. See original disclosure at page 6 second full paragraph, page 7 second and third full paragraphs, page 9 lines 1-9, page 12 first full paragraph and page 13 lines 12-16. The original disclosure fails to describe the amount of white filler in the first composition per se (in sharp contrast to the difference in white filler amounts) as being critical.

As to claims 24-26 and 32-34, the subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention (the new

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matter) is: (1) in claims 24 and 32, the combination of the subject matter of the first composition including at least 40% by weight carbon black and about 32% by weight white filler, (2) in claims 25 and 33, the combination of the subject matter of the first composition including at least 40% by weight carbon black and at least about 32% by weight white filler, and (3) in claims 26 and 34, the combination of the subject matter of the first composition including at least 40% by weight carbon black and between 32% by weight and 60% by weight white filler". The original disclosure, besides failing to describe 32%, fails to reasonably convey the above noted combinations since for example, the original disclosure fails to describes using 32% white filler and 40% black filler in the first composition, or using 120% white filler and 40% black filler in the first composition, or 32-60% white filler and 70% black filler in the first composition.

In claims 29 and 37, the subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention (the new matter) is: the subject matter of the at least first and second portions are not radially contiguous. The limitation of "not radially contiguous portions" is inconsistent with "axially contiguous portions". Figure 1 of applicant's disclosure for example clearly illustrates the first and second portions as being radially contiguous. The original disclosure fails to teach how to obtain axially contiguous portions which are not radially contiguous portions. Also, there is no definition of the negative limitation of "not radially contiguous" in the original disclosure.

7) The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8) Claims 1 and 22-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "a second portion is formed of a second composition" should be --the second portion is formed of a second composition-- in view of the description of "the tread band comprises at least first and second circumferential axially contiguous portions".

In claim 1, the scope of "at least some white filler" (emphasis added) is ambiguous.

As to claims 1, 20 and 30, the difference in scope between these claims is unclear.

In claim 30, the scope and meaning of the description of "the first reinforcing filler includes an amount of white filler effective to achieve a tyre operating temperature lower than a reference temperature"; it being noted that the original disclosure provides no guidance as to the meaning of this description (in contrast to the scope and meaning of "a difference of compositions between the at least first and second portions achieves a tyre operating temperature lower than a reference temperature").

As to claims 23 and 31, it is unclear what additional limitation is being added.

As to claims 25 and 33, it is unclear if "at least about 32%" reads on percentages above 100%. If not, then the difference in scope between claims 25 and 26 is unclear and the difference in scope between claims 33 and 34 is unclear.

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As to claims 29 (dependent on claim 22) and 37 (dependent on claim 30), the subject matter of “not radially contiguous portions” in claims 29 and 37 is inconsistent with the subject matter of “axially contiguous portions” required by claims 22 and 30.

9) Applicant is advised that should claim 1 be found allowable, claim 20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claims 1 and 20 have the same scope.

Applicant is advised that should claims 20-29 be found allowable, claims 30-37 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claims 20 and 30 have the same scope.

10) Claims 23 and 31 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

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The subject matter recited in claims 23 (dependent on claim 22) and 31 (dependent on claim 30) is inherently required by claims 22 and 30 respectively.

11) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12) **Claims 1 and 22-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Europe '452 (Europe 658452) in view of Crawford et al (Europe 732229) and Europe '332 (EP 627332) and optionally Europe '822 (EP 105822).**

Europe '452 discloses a tire having a tread comprising a "first conductive portion" (at least one conductive insert which contacts the ground) and a "second silica reinforced portion" (the remainder of the tread which contacts the ground). Europe '452 teaches that the "first portion" includes elastomer and a high carbon black content and that the "second portion" includes elastomer and high silica content. The portions are axially contiguous and can be circumferential. Europe '452 teaches that the silica gives the tire reduced rolling resistance and better hysteretic features. Europe '452 teaches that the tire includes the tread, a carcass, beads and a belt. Europe '452 does not specifically recite including a minor amount of silica in the high carbon black containing conductive portion.

Europe '229, directed to silica reinforced treads, discloses a tread comprising 30-100 phr silica and optionally up to 20 phr carbon black and an outer carbon black reinforced rubber tread

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cap which is electrically conducting comprising 25 to 100 phr carbon black. See page 4. Europe '229 teaches that conventional tire rubber including its tread portion is "typically reinforced with carbon black reinforcing filler and with minimal, if any, of silica". See page 2. Europe '229 teaches that by the term carbon black reinforced, "it is meant that the rubber components of the tire carcass rubber which are carbon black reinforced, contain a quantitative amount of carbon black reinforcement, normally at least 25 phr, and a minimal amount, if any, of silica and the weight ratio of carbon black to silica is at least 5/1". See page 2. Europe '229 teaches that the outer top cap layer is "primarily carbon black reinforced rubber composition".

Each of Europe '452 and Europe '229 solve the problem of electrostatic build up using the same solution of providing a silica reinforced tread portion with a carbon black conducting portion.

As to claims 1 and 22-37, it would have been obvious to one of ordinary skill in the art to provide the silica reinforced portion(s) and the conducting portion(s) [the insert(s)] of the tread of Europe '452 *such that* the silica reinforced portion(s) has reinforcing filler having at least 20% silica and a minor amount of carbon black, the conducting portion (s) has reinforcing filler having at least 40% carbon black and a minor amount of silica, *so that* a difference of compositions between the at least first and second portions achieves a tyre operating temperature lower than a reference temperature (claims 1, 20) / the first reinforcing filler includes an amount of white filler effective to achieve a tyre operating temperature lower than a reference temperature (claim 30) *in view of*:

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(a) Europe '452's teaching that the **silica reinforced portion** of the tread has high silica content and low carbon black content and the **conducting portion** in the tread is reinforced with carbon black,

(b) Crawford's suggestion to provide a **silica reinforced portion** of a tread such that it comprises 30-100 phr silica and optionally up to 20 phr carbon black and a **conducting portion** of a tread (an outer carbon black reinforced rubber tread cap) such that it comprises 25 to 100 phr carbon black and a minimal amount, if any, of silica and optionally

(c) Europe '822's teaching to provide one layer of a tread having carbon black and silica with a different amount of carbon black and silica than that in a another layer of the tread so as to provide the layers with different properties of tear and cut resistance and heat resistance.

The description regarding a lower tire working temperature / tire operating temperature fails to require compositions different than that suggested by the combination of Europe '452 and Crawford et al. There is no evidence of record showing that the claimed tire achieves a lower temperature than Europe '452; it being emphasized that the tread of Europe '452 like the tread of applicant includes two circumferential axially contiguous portions of different compositions wherein one of the portions is carbon black reinforced whereas the other portion is silica reinforced.

As to the claimed hollows and grooves, it would have been obvious to one of ordinary skill in the art to provide the tread of Europe '452 with grooves and hollows since (a) Europe

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'452 suggests providing the tread with circumferential grooves and transverse cutouts so as to define blocks in rows and (b) it is well known / conventional in the tread art to provide a tread with grooves and hollows to improve water draining and traction as evidenced for example by Europe '332 -Europe '332 teaching providing a tread with circumferential grooves and transverse grooves as shown in figure 1 so that the tire has efficient draining action of water and tractive features while also having low rolling noise.

Hence: Crawford (Europe '229) suggests including a minor amount of silica in the conducting portions of Europe '452 which are carbon black reinforced. Europe '229 teaches using a tread containing 30-100 parts silica (white filler) *and* an outer tread cap containing 25-100 parts carbon black (black filler). In other words, Europe '229 teaches toward (instead of away from) a tread with a white portion *and* a black portion. One of ordinary skill in the art would readily understand from a fair reading of Europe '229, which includes the description of "said tread cap being primarily silica reinforced and said outer tread cap being primarily carbon black reinforced rubber composition" (page 6 lines 9-10, emphasis added) that Europe '229 suggests a first portion having 30-100 silica and a minor amount (0-20 parts) carbon black and a second portion having 25-100 parts carbon black and a minor amount silica. Applicant has failed to provide any argument as to why "primarily" in the above quoted portion of Europe '229 must be read as --only-- so as to exclude inclusion of silica in the carbon black reinforced outer tread cap. Furthermore: Europe '452 and Europe '229, like applicant, disclose a tread having a silica (white) reinforced portion (a white portion) and a carbon black reinforced portion (black portion).

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Europe '452 and Europe '229, like applicant, disclose including a minor amount of carbon black in the silica reinforced portion. The disclosure in Europe '229 to use 30-100 parts silica (white filler) and 0-20 parts carbon black fairly suggests the limitation of at least 20% silica - applicant having provided no specific argument to the contrary. Europe '229, like applicant, suggests including a minor amount of silica in the carbon black reinforced portion. **No unexpected results over Europe '452 have been shown; it being emphasized that applicant obtains a reduced working temperature by using a white filler difference of at least 20% and that the white filler difference in Europe '452 is 100%.**

With respect the optional Europe '822, Europe '822's disclosure to use portions having carbon black and silica in a tread is consistent with Europe '229's teaching of "said outer tread cap being primarily carbon black reinforced rubber composition" (emphasis added).

As to dependent claims: As to claims 23-26 and 31-34, the claimed percentage of carbon black and white filler in the first composition would have been obvious in view of: (a) Europe '452's teaching to use carbon black in the conducting portion of the tread, (b) Crawford et al's suggestion to use a minor amount of silica in combination with carbon black in the conducting portion of the tread and optionally (c) Europe '822's suggestion to use silica and carbon black in a portion of a tread. As to claims 27 and 35, the claimed difference would have been obvious in view of Europe '452's suggestion to use high silica content in the silica reinforced portion but not the conducting portion. As to claims 28-29 and 36-37, note the arrangement of the different tread portions illustrated in figure 1 or figure 2 of Europe '452.

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13) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14) **Claims 1 and 22-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36-37, 39-40, 42, 45-46 and 49 of copending Application No. 08/946,233 in view of Europe '332 (EP 627332), Takino et al (US Patent 5,225,011) and Rubber Technology and Manufacture by Blow and optionally Knill (US Patent 4,319,620).**

Claims 36-37, 39-40, 42, 45-46 and 49 of 08/946,233 describe a method including making a tire having a tread band having reduced working temperature / tire with a tread including a first portion of specified composition and a second portion of specified composition. With respect to the grooves and hollows of this application, it would have been obvious to provide the tread of the claims of copending 08/946,233 with the claimed grooves and hollows so as to define the claimed tread pattern in view of Europe '332 which teaches providing a tread with grooves and hollows for water draining. As to this application, it would have been obvious to provide the compositions of the claims of copending 08/946,233 as the claimed circumferential

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axial contiguous portions in view of Takino et al and optionally further in view of Knill teaching to provide portions of a tread having different compositions as circumferential axially contiguous portions. As to the tire construction, it would have been obvious to provide the tire of the claims of copending 08/946,233 with the claimed tire construction since such a tire construction and method of making same is well known / conventional as evidenced by Blow. The composition / properties of the portions in the claims of this application would have been obvious in view of the composition specified in the claims of the copending application - it being noted that the claims of this application fail to exclude materials other than carbon black and silica and that the composition of the claims of copending 08/946,233 and the composition of the portion in the claims of this application substantially overlap.

This is a provisional obviousness-type double patenting rejection.

15) REMARKS

Applicant's arguments filed 3-12-01 have been fully considered but they are not persuasive.

With respect to the obvious type double patenting rejection, no terminal disclaimer has been received in this application.

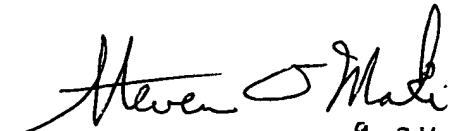
16) No claim is allowed.

17) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (703) 308-2068. The examiner can normally be reached on Monday to Friday from 7:00 AM to 3:30 PM. If attempts to reach

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the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for Art Unit 1733 is (703) 872-9310 (for before final) or (703) 872-9311 (for after final). Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Steven D. Maki
September 24, 2002


STEVEN D. MAKI
PRIMARY EXAMINER
~~GROUP 1300~~
AU 1733
9-24-02